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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,762	09/03/2002	David B Weiner	UPAP-0495	8614

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EXAMINER	
OUSPENSKI, ILIA I	
ART UNIT	**PAPER NUMBER**
1644	

DATE MAILED: 04/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/980,762	WEINER ET AL.	
	Examiner	Art Unit	
	ILIA OUSPENSKI	1644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-40 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) 1-40 are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

JM

DETAILED ACTION

1. Claims 1 – 40 are pending.

2. The instant application appears to be in sequence compliance for patent applications containing nucleotide sequence and/or amino acid sequence disclosures.

3. It is noted that claims 8 – 9, 14 – 16, and 37 – 38 are subject to withdrawal from consideration as multiple dependent claims which depend on multiple dependent base claims (PCT Rule 6.4(a) and 35 USC 112; see MPEP 1824 and 37 CFR 1.436).

However, in the interest of compact prosecution, the claims have been included in the restriction requirement set forth herein.

4. For examination purposes the following is noted:

The claims (e.g. claim 14) contain recitations of compositions comprising either a protein or a nucleic acid. As detailed below, these molecules are not so linked as to form a single general inventive concept under PCT Rule 13.1. Therefore, the restriction has been set forth for each as separate groups, irrespective of the format of the claims.

Restriction Requirement

5. Restriction is required under 35 U.S.C. 121 and 372: This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

I. Claim(s) 1 – 8 and 14 – 15, drawn to an isolated chimeric protein which does not include the C domain of CD80, and compositions thereof.

II. Claims 23 – 32, 35 and 37, drawn to an isolated chimeric protein which includes the C domain of CD80, and compositions thereof.

III. Claims 9 – 15, drawn to a nucleic acid encoding a chimeric protein which does not include the C domain of CD80, and vectors and compositions thereof.

IV. Claims 33 – 37, drawn to a nucleic acid encoding a chimeric protein which includes the C domain of CD80, and vectors and compositions thereof.

V. Claims 16 – 22, drawn to a method of immunizing an individual by administering a composition comprising a chimeric protein which does not include the C domain of CD80.

VI. Claims 16 – 22, drawn to a method of immunizing an individual by administering a composition comprising a nucleic acid encoding a chimeric protein which does not include the C domain of CD80.

VII. Claims 38 – 40, drawn to a method of immunosuppressing an individual by administering a composition comprising a chimeric protein which includes the C domain of CD80.

VIII. Claims 38 – 40, drawn to a method of immunosuppressing an individual by administering a composition comprising nucleic acid encoding a chimeric protein which includes the C domain of CD80.

6. The inventions listed as Groups I - VIII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The invention of Group I was found to have no special technical feature that defined the contribution over the prior art of Yang et al. (US Pat. Pub. 2004/0157296; see entire document).

Yang et al teach and claim an isolated mammalian B7 protein which comprises an IgV-like domain, but lacks an IgC-like domain (see entire document, in particular, e.g. claims 5 and 34), which anticipates the isolated protein of the instant claim 1.

Since Applicant's inventions do not contribute a special technical feature when viewed over the prior art they do not have a single general inventive concept and so lack unity of invention.

Species Election

7. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

8. The application contains claims directed to chimeric proteins comprising various numbers of domains in various combinations. If any one of Groups I – VIII is elected, applicant is required to elect a species wherein the chimeric protein comprises a single specified set of domains in a specified order.

These species do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features.

Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

9. If any one of Groups V – VI is elected, applicant is required to elect a species wherein the immunogen is:

A. an allergen,
B. a pathogen antigen,
C. an antigen associated with an autoimmune disease, or
D. an antigen associated with a hyperproliferative disease.

These species do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features.

Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

10. If any one of Groups VII – VIII is elected, applicant is required to elect a species wherein the individual:

A. has an autoimmune disease, or
B. is undergoing a transplant procedure.

These species do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features.

Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

11. Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. M.P.E.P. § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

12. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ILIA OUSPENSKI whose telephone number is 571-272-2920. The examiner can normally be reached on Monday-Friday 9 - 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on 571-272-0841. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ILIA OUSPENSKI
Patent Examiner
Art Unit 1644

March 22, 2005

PHILLIP GAMBEL, PH.D
PRIMARY EXAMINER
3/28/05